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10/699,650	11/04/2003	Johannes Gunther Simmel	P69175US0	5369

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EXAMINER

HUG, ERIC J

ART UNIT PAPER NUMBER

1731

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Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "between 2 mm to 4 mm", and the claim also recites "preferably 2.5 mm to 3.5 mm" which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-19 provide for the use of an endless steel band, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werthmann (DE 29 50 795 and US 5,183,551) in view of Applicant's admission of prior art.

DE 29 50 795 discloses a steel belt of a double-band press suitable for making embossed panels, whereby the belt is up to 2.0 mm thick and has an imprinted surface structure (depressions) which has been etched into belt to a depth of 0.3 mm (300  $\mu$ m). The roughness of the belt is not disclosed as being up to RZ 50.5  $\mu$ m, but the claimed roughness is a typical feature for smooth steel press belts without depressions, see Applicant's disclosure of what is known as prior art, and therefore it would be obvious to one skilled in the art that the belt of Werthmann has the same roughness in areas where no pattern has been formed.

Regarding claim 14 to a weldable round plate, Applicant has cited EP 0 820 833 as prior art disclosing the use of weldable round plates for repairing smooth press bands, one without depressions. US 5,183,551 relies on the teachings of EP 31 613, equivalently DE 29 50 795 (see abstract). Here, Werthmann discloses a tool for making the structured press bands disclosed in EP 31 613 and DE 29 50 795. The tool enables one to produce duplicates of a press band, particularly to replace worn or damaged bands with one of the same pattern. See column 3, line 67 through column 4, line 6. Werthmann does not disclose providing a round plate, per se, but

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the combined teachings of the prior art reference EP 0 820 833 and Werthmann would lead one skilled in the art to mass produce replacement plates for the press band with the same structure.

All other claimed features are addressed to the shape and size of the depressions and the pattern of the depressions on the band. However, these claimed features do not impart patentability, as they merely recite aesthetic properties of the steel band, and are deemed to be not critical to the function of the steel band. The Federal Circuit's predecessor court, the CCPA, has repeatedly held that presumption of obviousness was formed, based on the ken of routineer, whenever a difference was deemed minor. See *In re Dailey*, 149 USPQ 47 (CCPA 1976) where it was held that change in form or shape is an obvious engineering design, *In re Rose*, 105 USPQ 237 (CCPA 1955) where it was held that the size of an article is not a matter of invention, *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) where it was held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadler et al (US 6,436,553) in view of Applicant's admission of prior art.

Stadler discloses an endless steel band for a double-band press and a method of imparting a surface pattern to the steel band. Stadler discloses in column 2, line 3, that a typical steel press band is 1-3 mm thick. The belt is heat-treated to produce zones suitable for etching. Then the belt is etched to form recesses 18 (depressions). The recesses are a depth of from about 10-50% of the belt thickness (column 4, lines 1-7). For a 2 mm thick belt, this would result in an etch depth of about 0.2 to 1.0 mm (200 to 1000  $\mu$ m). The roughness of the belt is not disclosed as

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being up to RZ 50.5  $\mu\text{m}$ , but the claimed roughness is a typical feature for smooth steel press belts without depressions, see Applicant's disclosure of what is known as prior art, and therefore it would be obvious to one skilled in the art that the belt of Stadler has the same roughness in areas where no pattern has been formed.

As described above, all other claimed features are addressed to the shape and size of the depressions and the pattern of the depressions on the band. However, these claimed features do not impart patentability, as they merely recite aesthetic properties of the steel band, and are deemed to be not critical to the function of the steel band. The Federal Circuit's predecessor court, the CCPA, has repeatedly held that presumption of obviousness was formed, based on the ken of routineer, whenever a difference was deemed minor. See *In re Dailey*, 149 USPQ 47 (CCPA 1976) where it was held that change in form or shape is an obvious engineering design, *In re Rose*, 105 USPQ 237 (CCPA 1955) where it was held that the size of an article is not a matter of invention, *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) where it was held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thielman (US 6,908,295) discloses a steel press band for a double-band embossing press, the band having an embossed overlay layer that provides surface embossments of up to 1000 microns in depth in thermoplastic materials.

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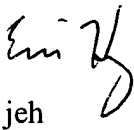
Held (US 4,557,778) discloses production of a textured belt for a double-band press, the belt provided with a negative of the pattern to be imparted to a structural laminate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is 571 272-1192.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
jeh

ERIC HUG  
PRIMARY EXAMINER